

REMARKS

The Office Action dated July 7, 2006 has been received and considered. In this response, claims 1, 10, 14, 18 and 21 have been amended. The amendments to the claims do not narrow the scope of the claims and support for the amendments may be found in the specification and drawings as originally filed. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

Anticipation Rejection of Claim 10

At page 2 of the Office Action, claim 10 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lee (U.S. Patent No. 6,402,634 B2). This rejection is hereby respectfully traversed with amendment. Claim 10 has been amended solely to place it in better condition for allowance and to advance prosecution.

Lee discloses an instrumented golf club and system. Lee teaches, as shown in Figures 4 and 5 and col. 5, lines 16-31, that the instrumented gold club system has plurality of sensors 62, 64, 66, 68, 98, 102, 104, 124, 126, 128 and 130, which are distributed from grip 12, shaft 14 through club head 18. Data from the sensors are carried by wires 72, 74, 76, 80, 82, 84, 108, 110 and 112 are directed to a strain gauge conditioning board 122, disposed in club head 18 (col. 7, lines 24-27).

Thus, Lee teaches a distributed sensor instrumented golf club, which by the very nature and arrangement of its components does not allow for the interchanging of the club head or club shaft. It does not teach or suggest, expressly or inherently an instrumented golf club having an electronic components unit disposed solely in the shaft of the instrumented golf club or sports device.

Furthermore, Lee does not teach or suggest, expressly or inherently an electronic components unit cable of being inserted solely into the shaft of a sports device such as a tennis racket, baseball bat or racquet ball racket. Applicant submits that the swing dynamics apparatus of the Lee reference cannot be removed from the instrumented golf club disclosed in Lee. To utilize the teachings of Lee each club in a golf bag would have

to be customized to employ Lee's teachings. Wherein, in the present invention the electronics component unit can simply be removed from one golf club, i.e. driver, and placed in a second golf club, a putter with ease, without creating an entirely new club. Furthermore, the present invention can be utilized in other racket sports, wherein for instance a tennis player can change rackets and simply insert the electronics component unit into the new racket in mere moments and continue playing or practicing and record swing dynamics from that racket to use for comparison purposes at a later time.

M.P.E.P. § 2131 states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1987).

Applicant submits that claim 10, as amended, is not expressly or inherently described and that each and every element is not disclosed in the Lee prior art reference. Therefore, in view of the foregoing, Applicant respectfully requests the withdrawal of the § 102(b) rejection of claim 10 and its timely allowance at this time.

Obviousness Rejection of Claims 1-3, 6-9, and 14-21

At page 3 of the Office Action, claims 1-3, 6-9, and 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and in view of Zeiner-Gundersen (U.S. Patent No. 5,941,779). This rejection is hereby respectfully traversed with amendment.

MPPEM § 2143.01 states that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant asserts that with respect to independent claims 1 and 18, which have been amended solely to place claims 1 and 18 in better condition for allowance and to advance prosecution, and dependent claims 2-3 and 8-9 and 21, which depend from independent claims 1 and 18, respectively, that the cited reference of Lee and Lee in view of Zeiner-Gunderson, taken alone or in combination do not teach or suggest an "removable electronic components unit inserted solely into the shaft" of the sports device. A careful review and analysis of the Lee reference discloses a distributed sensor instrumented club. With sensors being placed in the shaft and the club head, with connecting wires providing telemetry to a connecting board in the head of the club. Lee does not teach or suggest the placing of a removable electronic components unit solely in the shaft of the instrumented golf club or sporting device.

With respect to the Zeiner-Gunderson reference, a carefully review and analysis discloses a device that is either permanently attached to the sporting device or temporarily attached to the sporting device. The Zeiner-Gunderson reference fails to teach or suggest disposing solely within the sporting device's shaft a removable electronic components unit, capable of measuring a participants swing dynamics.

Applicant asserts that the only suggestion to place a removable electronic components unit solely within the shaft of a sporting device comes from Applicant's disclosure. MPEP § 2141 states specifically that when applying 35 U.S.C. § 103, one of the tenets of patent law that must be adhered to is that the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Applicant further submits that one of the points of novelty of the present invention is its easy of use and the ability to be placed in other sporting devices without any or very little change to the sporting device itself. None of the cited references taken either alone or in combination teaches or suggests this point of novelty or any of the other enumerated points of novelty as disclosed and claimed.

In view of the forgoing, it is respectfully submitted that the obviousness rejection of claims 1-3, 8-9, 18 and 21 is improper at this time and withdrawal of this rejection and their timely allowance is respectfully requested.

With respect to claims 6-7, 14-15 and 19-20, which depend from independent claims 1, 10 and 18 respectively, Applicant asserts that Lee in view of Zeiner-Gunderson, taken alone or in combination, fails to teach or suggest the placing of a removable electronic components unit solely within the shaft of a sports device and furthermore the placing of the electronic components unit from one device into a second device.

With respect to the Lee reference, Applicant asserts that Lee invention would have to be totally disassembled to be placed into a second device and be rendered totally inoperable for its intended purpose.

A review of the abstract of the Zeiner-Gunderson reference, cited with emphasis, a device for improving the performance of a golfer, particularly the repetitive correct swinging of the club, is preferably mounted on a standard golf club shaft, in place of a conventional head, but alternatively could be made to be temporarily attached to the head or shaft of any standard golf club. The subject device has a housing containing two directional gyros, a power source, a set of sensors, and a like set of alarms responsive to the sensors to give an audible and/or tactile alarm when the golfer's swing is outside that of each directional gyro's predetermined and set rotating direction, Applicant fails to see where the Zeiner-Gunderson reference teaches or suggests the placing of the removable electronic components unit solely inside of the sporting device.

Applicant respectfully requests, that the Examiner points to the specific location in the reference or cited references where these limitations can be found. If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration, pursuant to MPEP § 2144.04, setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2), of knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based, See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

In view of the foregoing, it is respectfully submitted that the Office Action fails to establish that Lee and Zeiner-Gundersen disclose or suggest, alone or in combination, each and every limitation of claims 6-7, 14-15 and 19-20. Therefore, it is respectfully submitted that the obviousness rejection of claims 6-7, 14-15 and 19-20 is improper at this time and withdrawal of this rejection therefore is respectfully requested.

Obviousness Rejection of Claims 4-5, and 11-13

In the Office Action, claims 4-5, and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Zeiner-Gundersen and further in view of Hammond (U.S. Patent No. 3,945,646). This rejection is hereby respectfully traversed with amendment.

With respect to claims 4-5, and 11-13, Applicant reasserts the above arguments with respect to the Lee and Zeiner-Gunderson references. With respect to the Hammond reference, it does not teach or suggest the placing of a removable electronic components unit solely with the shaft of a sporting device. The applied references and cited references taken alone or in combination do not teach or suggest all of the limitations of claims 4-5 and 11-13.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 4-5, and 11-13 is improper at this time and withdrawal of this rejection, therefore is respectfully requested.

Conclusion

The Applicants respectfully submit that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

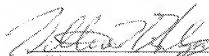
Amdt. Dated 11/08/2006

Response to Office action of 07/14/2006

Applicant respectfully requests an extension of time of one (1) month with which to file this Response.

Date: November 9, 2006

Respectfully submitted,



William N. Hulsey III, Reg. No. 33,402
Attorney for the Applicant
Hulsey^{IP} Intellectual Property Lawyers, P.C.
1250 S. Capital of Texas Highway
Building 3, Suite 310
Austin, Texas 78746
(512) 795-1295 (phone)
(512) 233-2602 (fax)